



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,789	01/22/2002	Amit Antebi	100/02139	5989

7590 11/10/2003
WILLIAM H. DIIPPERT
REED SMITH LLP
599 LEXINGTON AVENUE
29TH FLOOR
NEW YORK, NY 10022

EXAMINER

LE, UYEN CHAU N

ART UNIT PAPER NUMBER

2876

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/806,789

Applicant(s)

ANTEBI ET AL.

Examiner

Uyen-Chau N. Le

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 139-279 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 139-279 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Preliminary Amendment filed 22 January 2002.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 139-167, 188-198, 203-205, 220-225, 235-251, 262-267, drawn to a specific structure of a smart card, classified in class 235, subclass 492.
 - II. Claims 168-182, 214-217, 226-234, drawn to a specific system and method of interfacing a smart card and an electronic system, classified in class 235, subclass 380.
 - III. Claims 199-202, 252-261, 268-279, drawn to an authentication system of a smart card comprising, among other things, a biometric data, signature verification, etc., classified in class 235, subclass 382.
- IV. Claims 206-213, 218-219, drawn to a specific method of powering/charging a smart card, classified in class 235, subclass 451.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different invention I is in class/subclass 235/492 and invention II is in class/subclass 235/380. The

invention I including specific structures of a smart card defined in claims 139-167, 188-198, 203-205, 220-225, 235-251, 262-267 with respect to the prior art are a memory for storing information, communication means (e.g., antenna, etc.) for transmitting/receiving data, text to speech converter, etc. The invention II including a specific system and method of interfacing a smart card and an electronic system defined in claims 168-182, 214-217, 226-234 with respect to the prior art is transmitting and/or receiving digital data to/from an electronic system (e.g., a personal computer). Therefore, the invention I and the invention II are distinct from each other.

4. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different invention I is in class/subclass 235/492 and invention III is in class/subclass 235/382. The invention I including specific structures of a smart card defined in claims 139-167, 188-198, 203-205, 220-225, 235-251, 262-267 with respect to the prior art are a memory for storing information, communication means (e.g., antenna, etc.) for transmitting/receiving data, text to speech converter, etc. The invention III including an authentication system of a smart card defined in claims 199-202, 252-261, 268-279 with respect to the prior art is receiving and verifying inputted biometric data to determine whether or not the smart card is valid. Therefore, the invention I and the invention III are distinct from each other.

5. Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different invention I is in class/subclass 235/492 and invention IV is in class/subclass 235/451. The

invention I including specific structures of a smart card defined in claims 139-167, 188-198, 203-205, 220-225, 235-251, 262-267 with respect to the prior art are a memory for storing information, communication means (e.g., antenna, etc.) for transmitting/receiving data, text to speech converter, etc. The invention IV including a special technical feature of a specific method of powering/charging a smart card defined in claims 206-213, 218-219 with respect to the prior art are receiving and converting ultrasonic waves/light waves/ambient RF radiation for later powering the operation of the smart card. Therefore, the invention I and the invention IV are distinct from each other.

6. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different invention II is in class/subclass 235/380 and invention III is in class/subclass 235/382. The invention II including an authentication system of a smart card defined in claims 168-182, 214-217, 226-234 with respect to the prior art is receiving and verifying inputted biometric data to determine whether or not the smart card is valid. The invention III including a specific system and method of interfacing a smart card and an electronic system defined in claims 199-202, 252-261, 268-279 with respect to the prior art is transmitting and/or receiving digital data to/from an electronic system (e.g., a personal computer). Therefore, the invention II and the invention III are distinct from each other.

7. Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different

invention II is in class/subclass 235/380 and invention IV is in class/subclass 235/451. The invention II including an authentication system of a smart card defined in claims 168-182, 214-217, 226-234 with respect to the prior art is receiving and verifying inputted biometric data to determine whether or not the smart card is valid. The invention IV including a special technical feature of a specific method of powering/charging a smart card defined in claims 206-213, 218-219 with respect to the prior art are receiving and converting ultrasonic waves/light waves/ambient RF radiation for later powering the operation of the smart card. Therefore, the invention II and the invention IV are distinct from each other.

8. Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different invention III is in class/subclass 235/382 and invention IV is in class/subclass 235/451. The invention III including a specific system and method of interfacing a smart card and an electronic system defined in claims 199-202, 252-261, 268-279 with respect to the prior art is transmitting and/or receiving digital data to/from an electronic system (e.g., a personal computer). The invention IV including a special technical feature of a specific method of powering/charging a smart card defined in claims 206-213, 218-219 with respect to the prior art are receiving and converting ultrasonic waves/light waves/ambient RF radiation for later powering the operation of the smart card. Therefore, the invention III and the invention IV are distinct from each other.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

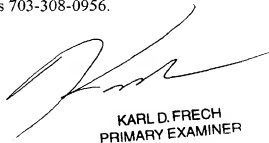
Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on SUN, M, W, F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Uyen-Chau N. Le
October 24, 2003


KARL D. FRECH
PRIMARY EXAMINER